

Serial No.: 09/690,366
Response to Office Action of 07/26/2005

Docket No. 1005.6
Customer No. 53953

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 2, 4-7, 9-12, and 14-21, 23-26 and 28-30 have been amended. Claims 1, 2, 4-7, 9-12, and 14-30 are pending. No new matter has been added.

Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

Rejection of the claims

The Office Action rejected claims 1, 6 and 11 under 35 U.S.C. § 112, second paragraph. Applicant has made an earnest attempt to amend the claims in a manner that overcomes such rejection. The amended claims no longer include the following phrases, which were cited in the Office Action: *"storing a version of a hardcopy paper"*; *"content of the likeness"*; *"the detected reference being associated with a second location"*; *"embedding a link within the version between the first location and the second location"*; and *"the first location being: displayable on the display device as part of the likeness."*

The Office Action rejected claims 1, 6 and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,643,663 ("Dabney") in view of U.S. Patent No. 6,401,075 ("Mason").

As amended, claim 1 recites:

1. A method performed by a computer system, comprising:
 - storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
 - at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
 - in response to the detected reference, embedding a hyperlink within the first location; and
 - when the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location.

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As amended, claim 6 recites:

6. A system, comprising:
a computing device for:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the first location; and
when the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location.

As amended, claim 11 recites:

11. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detect a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embed a hyperlink within the first location; and
when the first location is displayed on the display device, highlight the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location; and
apparatus from which the computer program is accessible by the computer system.

Dabney and Mason fail to teach the combination of elements in amended claims 1, 6 and 11. MPEP § 2143.01 states: "The mere fact that references can be combined or modified does *not* render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the

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examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...”

In fact, Dabney actually teaches away from the combination of elements in amended claims 1, 6 and 11. For example, in citing Dabney, the Office Action states, “A *web editor* reviews and *edits* the data stored in the content management system and *assigns* the data to target locations appropriate for the data to be assigned and *approves* the data for use in a webpage” (emphasis added). Also, the Office Action states, “The reference suggests a reference to a second location, a target location, *designated by the web editor*” (emphasis added). Thus, according to the Office Action’s own statements, Dabney expressly teaches that a *human* “web editor” *manually* performs such operations.

In Dabney, such fact (i.e., a *human* “web editor” *manually* performs such operations) fails to anticipate, and *in fact expressly teaches away from*: (a) claim 1, which expressly recites that *all* of its elements are “*performed by a computer system*”; (b) claim 6, which expressly recites “*a computing device for*” performing *all* of its recited elements; and (c) claim 11, which expressly recites “*a computer program processable by a computer system for causing the computer system to*” perform *all* of its recited elements.

Thus, in relation to amended claims 1, 6 and 11, Dabney fails to teach, or even suggest, any basis for combining in a 35 U.S.C. § 103 rejection.

MPEP § 2142 states: “...the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole.’” Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to amended claims 1, 6 and 11, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant’s teachings in its own specification. Accordingly, the PTO’s burden of factually supporting a prima facie conclusion of obviousness has not been met.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

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Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 6 and 11.

Dependent claims 2, 4, 5 and 16-20 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 7, 9, 10 and 21-25 depend from and further limit claim 6 and therefore are allowable.


Dependent claims 12, 14, 15 and 26-30 depend from and further limit claim 11 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 4-7, 9-12, and 14-30 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

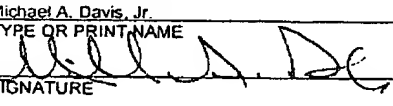
Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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